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MARSHALL, GERSTEIN & BORUN LLP 233 SOUTH WACKER DRIVE 6300 WILLIS TOWER CHICAGO, IL 60606-6357			SWARTZ, JAMIE H	
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

<b>Application No.</b> 09/993,992	<b>Applicant(s)</b> PHELAN ET AL.	
<b>Examiner</b> JAMIE H. SWARTZ	<b>Art Unit</b> 3684	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1)  Responsive to communication(s) filed on 20 May 2010.
- 2a)  This action is **FINAL**.                                    2b)  This action is non-final.
- 3)  Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4)  Claim(s) 1-35 is/are pending in the application.  
4a) Of the above claim(s) 1-6,34 and 35 is/are withdrawn from consideration.
- 5)  Claim(s) \_\_\_\_\_ is/are allowed.
- 6)  Claim(s) 1-6,34 and 35 is/are rejected.
- 7)  Claim(s) \_\_\_\_\_ is/are objected to.
- 8)  Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9)  The specification is objected to by the Examiner.
- 10)  The drawing(s) filed on \_\_\_\_\_ is/are: a)  accepted or b)  objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11)  The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12)  Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a)  All    b)  Some \*    c)  None of:  
1.  Certified copies of the priority documents have been received.  
2.  Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3.  Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1)  Notice of References Cited (PTO-892)
- 2)  Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3)  Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4)  Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5)  Notice of Informal Patent Application
- 6)  Other: \_\_\_\_\_.

## DETAILED ACTION

### *Status*

1. Claims 1-34 are pending. Claims 7-33 have been withdrawn. Claim 35 was added. Claims 1 and 34 are currently amended. Claims 1-6 and 34-35 are currently examined.

### *Response to Arguments*

2. Applicant's arguments with respect to claims 1-6 and 34 have been considered but are moot in view of the new ground(s) of rejection.

3. Applicant's arguments filed May 20, 2010 have been fully considered but they are not persuasive. On page 10 of applicant's arguments the applicant has argued that claim 1 "enables automatic and standardized collection of payment history data." In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., "standardized collection of payment history data") are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

4. Applicant has argued on page 11 that Duhon does not teach "this feature." It is unclear if the applicant is pointing to the paragraph before or the current paragraph. The

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statement is vague. The applicant has argued that there would be no motivation to combine Duhon with anything to teach "this feature." Again the statement is too vague. However, in response to applicant's argument that there is no teaching, suggestion, or motivation to combine the references, the examiner recognizes that obviousness may be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988), *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992), and *KSR International Co. v. Teleflex, Inc.*, 550 U.S. 398, 82 USPQ2d 1385 (2007). The applicant has argued that "Duhon is generally silent with respect to collecting the credit data information." The examiner respectfully disagrees. Duhon teaches credit collection and reporting which can be seen in at least the abstract as well as throughout the specification. The applicant has argued that Duhon does not teach the Internet. The examiner respectfully disagrees and would like to point to the teaching in at least ¶ 37 of customers going online and using a WAN. The applicant has argued that Duhon does not specifically teach the installing of a computer program. The examiner will agree that the word install does not specifically exist within the specification however, Duhon teaches using different software programs in ¶ 43 and 46. Software programs are required to be installed on a computer before the program can run. Is the applicant claiming that using a program wouldn't previously require an installation of a program?

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5. On page 12, applicant has argued that Duhon "is a system that provides a user with many options and alternatives in ascertaining the credit history of a customer." The examiner agrees that part of Duhon's invention does not specifically teach what the applicant is claiming however the motivation or objective of the Duhon invention is not required to be the same as the current invention, the Duhon invention merely needs to teach the claimed invention. The applicant argues that the only mention of data collection in Duhon is in ¶ 84 but doesn't require the Internet. The examiner would like to quote ¶84 "data is introduced into the system via various media types including but not limited to round reel tape, cartridge tape, floppy diskettes and electronic transmissions." And would like to point the applicant to the words "not limited to" and "electronic transmissions."

### ***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claim 35 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claim 35 is rejected under 35 U.S.C. 101 because the broadest reasonable interpretation of the claim is drawn to a computer readable medium that covers forms of non-transitory tangible media and transitory propagating signals per se in view of the ordinary and customary meaning of computer readable media, particularly when the specification is silent. See MPEP 2111.01. Because the broadest reasonable

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interpretation of a claim covers a signal per se, the claim is rejected under 35 U.S.C. § 101 as covering non-statutory subject matter. See *In re Nuijten*, 500 F.3d 1346, 1356-57 (Fed. Cir. 2007). Further applicant in paragraph 17 states the use of non-transitory tangible media.

***Claim Rejections - 35 USC § 112***

6. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

7. Claim 35 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The applicant has claimed “formatting the payment history data file according to a format associated with the credit exchange system.”

There is no support in the original disclosure for the formatting to be in a format associated with the credit exchange system.

8. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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9. Claim 35 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

10. Regarding claim 35, the phrase "each of a plurality of members has financial information related a respective plurality of customers" renders the claim indefinite because it is unclear what specifically the applicant is claiming.

***Claim Rejections - 35 USC § 102***

11. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

12. Claim 35 is rejected under 35 U.S.C. 102(e) as being anticipated by Duhon (US 20010011245 A1).

13. Regarding claim 35, Duhon teaches a credit exchange system that includes a plurality of members and a lease credit information apparatus accessible via the Internet (¶ 37), wherein each of the plurality of members has financial information related a respective plurality of customers (¶ 12-14). Duhon teaches wherein the computer-

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readable medium is installed on an accounting system of a member (§ 43). Duhon teaches generating a plurality of records associated with a plurality of customers, each of the plurality of records including payment history data indicative of a quality of credit of a respective one of a plurality of customers (§§12-14) Duhon teaches generating a plurality of customer identifiers to identify a respective customer with which each of the plurality of records is associated (§ 83). Duhon teaches causing the payment history data to be transmitted for processing to the lease credit information apparatus via an Internet connection (§§43, 84). Duhon teaches formatting the payment history data file according to a format associated with the credit exchange system (§ 42, 70).

***Claim Rejections - 35 USC § 103***

14. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

15. Claims 1, 2, and 34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Duhon (US 20010011245 A1) in view of Coleman (US 5708828 A) in further view of Inso Corporation (December 9, 1997).

16. Regarding claim 1, Duhon teaches automatically exchanging credit information (see at least abstract). Duhon teaches obtaining payment history data from a member's accounting system, wherein the payment history data is associated with at least one of



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a plurality of customers (§ 12). Duhon teaches creating a payment history file that contains the payment history data (§ 12-13). Duhon teaches loading the payment history file through the Internet to a system database (§ 12-13). Duhon teaches validating the payment history data by comparing the obtained history data to a data record associated with the first customer if the data record associated with the first customer is present in a centralized data repository (§ 84). Duhon teaches formatting the payment history file into a payment history report (§ 56, 67, 70). Duhon teaches evaluating the payment history data in the payment history file (§ 55). Duhon teaches storing the payment history report in the centralized data repository (see at least abstract, § 12). Duhon teaches providing the payment history report to a requestor upon receiving a request corresponding to the first one customer (§ 85-86). Duhon teaches using different software programs in § 43 and 46 that were previously installed on the computer. Duhon does not specifically teach formatting a payment history by converting some of the payment history into a predetermined format. However, Coleman teaches formatting a history file into a predetermined format for storage in a system database, including converting the at least some of the history data in one format into a predetermined format (abstract). This known technique is applicable to the system of Duhon as they both share characteristics, namely, they are both directed to the collection and storage of data. One of ordinary skill in the art would have recognized that applying the known technique of Coleman would have yielded predictable results and resulted in an improved system. It would have been recognized that applying the technique of Coleman to the teachings of Duhon would have yielded predictable results

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because the level of ordinary skill in the art demonstrated by the references applied shows the ability to incorporate such data processing features into similar systems. Further, converting data allows for the data to be put into a standardized format. The combination of Duhon and Coleman does not specifically teach propriety format conversion. However, Inso Corporation teaches formatting a proprietary format into a predetermined format (pg. 1-4). This known technique is applicable to the system of Coleman as they both share characteristics, namely, they are both directed to the conversion of a format into another standard format. One of ordinary skill in the art would have recognized that applying the known technique of Inso Corporation would have yielded predictable results and resulted in an improved system. It would have been recognized that applying the technique of Inso Corporation to the teachings of Coleman would have yielded predictable results because the level of ordinary skill in the art demonstrated by the references applied shows the ability to incorporate such data processing features into similar systems. Further, converting from a proprietary format allows for the data to be put into a standardized format.

17. Regarding claim 2, Duhon teaches creating scoring and modeling of customer information (§§ 76, 79).

18. Regarding Claim 34, Duhon teaches a method for automatically obtaining and exchanging credit information (see at least abstract). Duhon teaches obtaining customer credit and business information data from an accounting system of a commercial

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lending company over the Internet, wherein the customer credit and business information is associated with at least a first customer and includes at least one of lease obligation, loan obligation, and payment history of the at least the first customer (§ 50). Duhon teaches attempting to retrieve customer data associated with the first customer from a centralized data repository (§ 6, 12). Duhon teaches if the customer data is successfully retrieved: validating the customer credit and business information by comparing the obtained customer credit and business information to the customer data associated with the first customer (§ 84); formatting the customer credit and business information into a payment history report (§ 56, 67, 70); storing the payment history report in the centralized data repository (see at least abstract, §12); and providing the payment history report to a requestor upon receiving a request corresponding to the at least the first customer (§ 85). Duhon teaches using different software programs in § 43 and 46 that were previously installed on the computer. Duhon does not specifically teach formatting a payment history by converting some of the payment history into a predetermined format. However, Coleman teaches formatting a history file into a predetermined format for storage in a system database, including converting the at least some of the history data in one format into a predetermined format (abstract). This known technique is applicable to the system of Duhon as they both share characteristics, namely, they are both directed to the collection and storage of data. One of ordinary skill in the art would have recognized that applying the known technique of Coleman would have yielded predictable results and resulted in an improved system. It would have been recognized that applying the technique of Coleman to the teachings of

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Duhon would have yielded predictable results because the level of ordinary skill in the art demonstrated by the references applied shows the ability to incorporate such data processing features into similar systems. Further, converting data allows for the data to be put into a standardized format. The combination of Duhon and Coleman does not specifically teach propriety format conversion. However, Inso Corporation teaches formatting a proprietary format into a predetermined format (pg. 1-4). This known technique is applicable to the system of Coleman as they both share characteristics, namely, they are both directed to the conversion of a format into another standard format. One of ordinary skill in the art would have recognized that applying the known technique of Inso Corporation would have yielded predictable results and resulted in an improved system. It would have been recognized that applying the technique of Inso Corporation to the teachings of Coleman would have yielded predictable results because the level of ordinary skill in the art demonstrated by the references applied shows the ability to incorporate such data processing features into similar systems. Further, converting from a proprietary format allows for the data to be put into a standardized format.

19. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Duhon (US 20010011245 A1) in view of Coleman (US 5708828 A) in further view of Inso Corporation (December 9, 1997) in view of DeFrancesco et al. (US 5878403 A).

20. Regarding claim 3, Duhon teaches automatically obtaining and exchanging credit information (see at least abstract). Duhon teaches opening the payment history;

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validating the format of the payment history file; loading the payment history file into a system database file (§ 84). Duhon teaches performing a scrubbing routine on the payment history data to remove suspect payment history data (§ 84). Duhon teaches performing matching routines on the payment history data, wherein new lenders are created if no matching lender is found in the system database, and at least one of adding or updating payment history data in the system database is performed if a matching lender is found in the system database (§ 50). Duhon does not specifically go into the details of the payment history file type. However, DeFrancesco teaches determining the payment history file type (col. 26, lines 21-59). Duhon teaches data storage and processing system for credit data reporting. DeFrancesco teaches a computer implemented credit application analysis and decision routing system. It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Duhon to include the details of figuring out the payment history file type. Each credit reporting company uses their own file type for storing payment history. It is important for collaborative reporting and formatting between multiple lenders and multiple reporting agencies to know what type the history file is.

21. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Duhon (US 20010011245 A1) in view of Coleman (US 5708828 A) in further view of Inso Corporation (December 9, 1997) in view of DeFrancesco et al. (US 5878403 A) in further view of Mullins (August 1998).

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22. Regarding claim 4, Duhon teaches a scrubbing routine on the payment history and modifying the payment history data (§ 84). Duhon does not specifically teach thresholds within a scrubbing routine. However, Mullins teaches performing a scrubbing routine on the data further comprises the step of modifying the suspect data based upon thresholds set by the member (pg. 1-6). Duhon teaches data storage and processing system for credit data reporting. Mullins teaches data mining and data cleansing. It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Duhon to include the details of a threshold. It is important to validate data in order to prevent processing errors in the future. The threshold to data scrubbing is a necessity because data scrubbing is by nature something that could go on until infinity. It is a resource application problem. Some limits need to be placed in order to avoid using up all your resources. While these small errors may seem like a trivial problem, when merging corrupt or erroneous data into multiple databases, the problem may be multiplied by the millions. This so-called "dirty data" has been a problem as long as there have been computers, but the problem is becoming more critical as businesses are becoming more complex and data warehouses are merging data from multiple sources. There is no point in having a comprehensive database if that database is filled with errors and disputed information.

23. Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Duhon (US 20010011245 A1) in view of Coleman (US 5708828 A) in further view of Inso Corporation (December 9, 1997) in view of Official Notice now admitted prior art.

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24. Regarding claim 5, Duhon teaches automatically obtaining and exchanging credit information (see at least abstract). Duhon teaches formatting the payment history file into a payment history report (§§ 56, 67, 70). Duhon teaches providing the payment history report to a requestor upon receiving a request corresponding to the first one customer (§§ 85). Duhon does not specifically teach search criteria. However, Official notice now admitted prior art is taken that the six steps taken in claim 5 with respect to search criteria are old and well known in the art at the time of the invention to be basic steps in a typical search query. Every search query involves first having a criteria or search topic. The databases are then searched for whatever specific details that are desired. As each search is run a search history keeps the log of the search. If a match to the query is found the customer data is displayed. The final steps to a typical search query involve generating a report and either displaying it on a computer screen or printing the data out.

25. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Duhon (US 20010011245 A1) in view of Coleman (US 5708828 A) in further view of Inso Corporation (December 9, 1997) in view of Zoffel et al. (US 5274547 A).

26. Regarding claim 6, Duhon teaches automatically obtaining and exchanging credit information (see at least abstract). Duhon teaches scoring (§§ 76, 79). Duhon doesn't specifically go into all the details of what values are scored. However, Zoffel teaches

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computing summary and scoring information, including a high credit value, a total lease balance, total current payments, and a total number of times a customer had an overdue payment; and displaying the summary information (see at least table 4). Duhon teaches data storage and processing system for credit data reporting. Zoffel describes systems of creating credit reports. It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Duhon to include the details of credit scoring. Duhon uses the financial information such as bill payment and account balances used for credit scoring. It is the responsibility of a prudent business owner to evaluate the credit worthiness of customers before extending credit. Since the customer information and past credit history is in financial programs it would have been obvious to add credit evaluation to this tool in order to identify credit risks and problematic accounts.

### ***Conclusion***

27. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the



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shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JAMIE H. SWARTZ whose telephone number is (571)272-7363. The examiner can normally be reached on 8:00am-4:30pm Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kambiz Abdi can be reached on (571)272-6702. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/J. H. S./

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Examiner, Art Unit 3684

/Jennifer Liversedge/

Primary Examiner, Art Unit 3684